

PTO/SB/17 (12-04v2)
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FEE TRANSMITTAL For FY 2005		Complete if Known	
		Application Number	10/090440
		Filing Date	March 4, 2002
		First Named Inventor	Grant McFadden
		Examiner Name	M. Yu
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Art Unit	1642
TOTAL AMOUNT OF PAYMENT	(\$) 120.00	Attorney Docket No.	MDSP-P01-002

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 18-1945 Deposit Account Name: Ropes & Gray LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>
				<u>Fee (\$)</u> <u>Fee Paid (\$)</u>
<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other (e.g., late filing surcharge): 1251 Extension for response within first month	120.00

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	50,306
Name (Print/Type)	Yu Lu	Telephone	(617) 951-7268
		Date	December 29, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 12-30-04 Signature: Andrea Berio (Andrea Berio)



Attorney Docket No.: MDSP-P01-002

U.S.S.N. 10/090,440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: MCFADDEN <i>et al.</i> Serial No: 10/090,440 Filed: March 4, 2002 For: METHODS AND REAGENTS FOR REGULATING APOPTOSIS	Attorney Docket No. MDSP-P01-002 Art Unit: 1642 Examiner: Yu, Misook Confirmation No.: 3416
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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below:

<u>12-30-04</u> Date of Signature and of Mail Deposit	<u>Andrea Berlo</u> Andrea Berlo
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Mail Stop Amendment
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

Sir:

This response is filed in reply to the outstanding Restriction Requirement, mailed November 1, 2004, in connection with the above application. The period for response has been extended to Monday, January 3, 2005, by the accompanying petition for one month extension. Applicants hereby elect Group I, claims 1-25, *with traverse*, on the following grounds.

Applicants traverse this restriction requirement on the basis that the Groups, especially Groups I and III are so closely related and they share common features that would facilitate searching both groups at once. For example, claims in Groups I and III can be simultaneously searched by searching methods of identifying M11L-interacting proteins. In addition, the assay system used in Group I claims may at least overlap with that of Group II claims. Therefore, a simultaneous search and examination of all pending claims can be made without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Regarding the species election, Applicants submit that the Office Action does not properly set forth the species grouped together, and/or is not clear as to which species to elect from among several species. Since species is linked to the concept of genus, it would be improper to group species belonging to different genus together and require Applicants to elect only one of the improperly grouped species.

To expedite prosecution, Applicants assume that, among the 6 listed “species,” (1) – (4) belong to the same genus (the first genus), “species (5)” in fact correspond to another genus with two species (i.e., yeast two-hybrid or reverse two-hybrid); “species (6)” in fact correspond to yet another genus with two species (i.e., ITS or reverse ITS).

If this is what is intended, for the first genus, Applicants hereby provisionally elect, *for search purpose only*, Species “binding to the complex,” *with traverse*. Applicants elect this species with traverse, because the subject matter of the listed species under Group I are different species of the same Markush group. Pursuant to MPEP 803.02, “If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.” Applicants submit that such is the case here, particularly in view of the fact that there are only 4 species within the Markush group. Thus all species can be examined simultaneously without significant additional burden on the Examiner. In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

Presently, claims 1-25 read on the elected species.

For the second genus encompassing species yeast two-hybrid assay or yeast reverse two-hybrid assay, Applicants hereby provisionally elect, *for search purpose only*, Species “yeast two-hybrid assay,” *with traverse*. Applicants elect this species with traverse, because the subject matter of the listed two species are different species of the same Markush group. Pursuant to MPEP 803.02, “If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to

independent and distinct inventions.” Applicants submit that such is the case here, particularly in view of the fact that there are only 2 species within the Markush group. Thus all species can be examined simultaneously without significant additional burden on the Examiner. In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

Presently, claims 1-25 read on the elected species.

For the third genus encompassing species ITS or reverse ITS, Applicants hereby provisionally elect, *for search purpose only*, Species “ITS,” *with traverse*. Applicants elect this species with traverse, because the subject matter of the listed two species are different species of the same Markush group. Pursuant to MPEP 803.02, “If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.” Applicants submit that such is the case here, particularly in view of the fact that there are only 2 species within the Markush group. Thus all species can be examined simultaneously without significant additional burden on the Examiner. In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

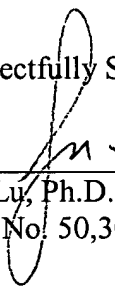
Presently, claims 1-25 read on the elected species.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition therefor and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: December 29, 2004

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Respectfully Submitted,



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